



UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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In re Application of Uwe Schoenrock et al. :
Serial No.: 09/132,799 :
Filed: August 13, 1998 : PETITION DECISION
Attorney Docket No.: BEIERSDORF-5 :

This is in response to applicants' petition, filed January 13, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on August 13, 1998. The application, as filed, contained claims 1-10. On May 26, 1999, the examiner mailed an Office action including a restriction requirement dividing the claims into 2 groups, and requiring a further election of a single species of peptide for examination. In a telephonic interview, applicants had elected Group I, claims 1-6, and the monomer oligopeptide Ac-VVRP-NH₂ as the species to be examined. The examiner withdrew claim 5 from consideration as drawn to a non-elected species, namely longer chain acyl derivatives of VVRP and another oligopeptide. In the response filed December 1, 1999, applicants argued that all acyl derivatives of VVRP should be examined. On February 24, 2000 the examiner mailed a final Office action, wherein it was explained that other species would be examined if the elected species was found to be patentable. Prosecution has continued since that time, with the examiner mailing 5 subsequent Office actions. In an amendment filed July 29, 2002 applicant submitted new claims. In an Office action mailed October 8, 2002 the examiner withdrew from consideration claim 21, drawn to longer chain acyl derivatives of VVRP, as drawn to non-elected species.

DISCUSSION

Applicants argue that it is unclear why longer chain acyl derivatives of VVRP are considered patentably distinct species, and that the examiner did not provide any reason. This argument is not persuasive because it is applicant's burden to show that the species are not patentably distinct. As stated in the first Office action on the merits, "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case." Absent any such evidence or admission, the examiner's position is not improper.

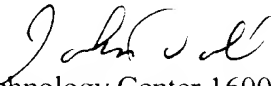
DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

The time period for response continues to run from the mailing date of the final rejection.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll 
Director, Technology Center 1600